

REMARKS

The Invention

In general, the present application relates to a system and method wherein a mobile data device is provided with a preferred roaming list that includes information indicating whether each network in the list (*e.g.*, a 3G network) supports 3G data capabilities (as opposed to, for example, 3G voice capabilities). This is advantageous because not all 3G networks are capable of supporting data services and by including information regarding the 3G data capabilities of the network in the preferred roaming list the battery life of the mobile data device is prolonged or preserved since the mobile data device will not attempt to access a 3G network lacking 3G data capabilities when 3G data capabilities are needed. Accordingly, the method includes a step of identifying which of the plurality of networks support a first one of the plurality of preference criteria by inspecting the first one of the plurality of preference criteria of each of the plurality of networks in a preferred roaming list.

Status of the Claims

Claims 29-33, and 35-36 are pending in the application.

Claims 29-33, and 35-36, are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The amendment is objected to under 35 U.S.C. § 132(a) because it introduces new matter into the disclosure.

Claims 29-30, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Aerrabotu et al.*, (U.S. Patent No. 6,993,336) in view of *Chiniga et al.* (U.S. Patent No. 6,415,148) and of *Seppanen et al.* (U.S. Patent No. 5,903,832).

Claims 31-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Aerrabotu* ('336) in view of *Chiniga* ('148) and *Seppanen et al.* ('832) as applied to Claims 30 and 38 and further in view of *Guilford et al.* (U.S. Patent Publication No. US2002/0087674 A1).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Aerrabotu* ('336) in view of *Chiniga* ('148) and *Seppanen et al.* ('832) as applied to Claim 29, and further in view of *Russell* (U.S. Patent Publication No.US2004/0249915).

Claims 36-41 and 43-44 have been canceled to reduce the issues in this response and any subsequent appeal.

Claims 29-33, 35; Rejected under 35 U.S.C. § 112

Claims 29-33, 35 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Examiner states that the specification does not have support for the recitation of a “mobile data device gives preference to various ones of the plurality of system preference criteria to create the ranking of available networks.”

Claim 29 has been amended to reflect language explicitly used in the specification to overcome the rejection under 35 U.S.C. § 112, first paragraph. That is, the step of providing information about the plurality of networks is recited in any of paragraphs 008, 009, 0013-0015; the description of the preferred roaming list is found in paragraphs 0025-0028, 0032, 0040, 0044, 0050; The step of waiting until the new network needs to be acquired is set forth in paragraphs 0053-0054; the step of identifying which of the plurality of networks support a first one of the plurality of preference criteria by inspecting the first one of the plurality of preference criteria of each of the plurality of networks in the preferred roaming list is set forth in paragraphs 0035-0051; and the steps of selecting the new network from the identified networks and starting a search for the selected new network is set forth in paragraphs 0059-0060.

As each of the recitations of Claim 29 are found in the original specification, the rejection under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement is no longer valid.

Claims 29-30, 35; Rejected under 35 U.S.C. § 103(a)

Claims 29-30, 35, 37-38, 43 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Aerrabotu et al.*, (U.S. Patent No. 6,993,336) in view of *Chiniga et al.* (U.S. Patent No. 6,415,148) and of *Seppanen et al.* (U.S. Patent No. 5,903,832).

Claim 29, as amended, now recites the step of identifying which of the plurality of networks support a first one of the plurality of preference criteria by inspecting the first one of the plurality of preference criteria of each of the plurality of networks in the preferred roaming list. The Examiner has not identified any prior art that performs this step. Accordingly, Claim 29, as well as all the claims dependent therefrom, are allowable over the cited art.

CONCLUSION

In view of the remarks above, Applicants respectfully submit that the application is in proper form for issuance of a Notice of Allowance and such action is requested at an early date.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. C. Jenkins', written in a cursive style.

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